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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,459	02/01/2000	Hanna Abi-Saleh	9826-032-999	4881

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EXAMINER

BRINICH, STEPHEN M

ART UNIT PAPER NUMBER

2624

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/495,459

Applicant(s)

ABI-SALEH ET AL.

Examiner

Stephen M. Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-16 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

Claims 9-16, while defining a computer program product, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A "computer program product" can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner

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suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-5, 7-20, & 22-24, insofar as claims 9-16 are understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbs in view of Koppolu et al.

Re claims 1, 4-5, 7, 9, 12, 14-15, 17, 20, & 22-23, Dobbs discloses (column 2, lines 12-61) a computer processor and printer arrangement that generates a test data structure (i.e. a test pattern and associated icon) for testing a printer driver by opening the associated application (the print driver) in the computer memory and a document (the test pattern) in order to produce a test print from the test data structure.

Re the recitation of a document "list", the set of document(s) selected for printing by the Dobbs printer arrangement read upon this "list".

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Dobbs does not disclose the use of information in a registry database to associate applications and documents. The use of a registry database to associate a plurality of applications with respective documents is known in the art as disclosed by the Koppolu et al description (column 1, lines 59-63) of the Windows 95™ registry.

Dobbs and Koppolu et al are combinable because they are from the field of accessing documents stored as computer-readable files and printing them on a printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a registry database to associate applications and documents in the printer driver test arrangement of Dobbs. The suggestion/motivation for doing so would have been in order to permit documents of various file formats opened by various applications to be used as test patterns (thus providing a test environment that closely approximates the actual use conditions of a printer).

Therefore, it would have been obvious to combine Dobbs with Koppolu et al to obtain the invention as specified in claims 1, 4-5, 7, 9, 12, 14-15, 17, 20, & 22-23.

Re the use of an automatic process of opening documents of various file formats opened by various applications for use as test patterns, the automating of a process is recognized as an

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expedient obvious to one of ordinary skill in the art (In re Venner, 120 USPQ 192).

Re claims 2, 10, & 18, Dobbs further discloses (column 3, lines 22-23) the selection of one of several print options.

Re claims 3, 11, & 19, the described user-selected icon (column 2, lines 54-55) is inherently a component of a graphical user interface.

Re claims 8, 16, & 24, Dobbs further discloses (column 3, lines 27-31) the generation and recording of a compatible print mode log.

Re claim 13, Dobbs further discloses (column 2, line 62 - column 3, line 10), an auto-learning arrangement whereby the printer driver is equipped with learned controls corresponding to particular print media types.

5. Claims 6 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbs in view of Koppolu as applied to claims 1-5, 7-20, & 22-24 above, and further in view of Weinberger.

Re claims 6 & 21, Dobbs further discloses (column 2, line 62 - column 3, line 10), an auto-learning arrangement whereby the printer driver is equipped with learned controls corresponding to particular print media types.

Dobbs discloses the use of a single printer driver. The use of multiple installed printer drivers on a computer system

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and the selection of a printer driver for a given print job is well known in the art as shown for example by Weinberger (column 4, lines 24-29).

Dobbs in view of Koppolu et al and Weinberger are combinable because they are from the field of accessing documents stored as computer-readable files and printing them on a printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use one of a set of multiple printer drivers.

The suggestion/motivation for doing so would have been in order to allow the use of multiple printers connected to a single computer

Therefore, it would have been obvious to combine Dobbs in view of Koppolu et al with Weinberger to obtain the invention as specified in claims 6 & 21.

Response to Arguments

6. Applicant's arguments filed 4/25/05 have been fully considered but they are not persuasive.

Re claims 1-7, 7-20, & 22-24, Applicant argues (4/25/05 Remarks: page 7, line 17 - page 8, line 28) that the art of record does not teach or suggest the claimed feature of

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automatically printing a list of specific documents, but rather manually printing a set of documents.

As noted above, the present claim language does not describe the recited "list" in a way which precludes the reading of a particular set of documents selected for printing as the "list". Also as noted above, the substitution of an automated process for a manual process has been judicially recognized as an expedient obvious to one of ordinary skill in the art.

Re claims 6 & 21, Applicant's argument (4/25/05 Remarks: page 9, lines 1-9) refers back to the above addressed arguments re claims 1-7, 7-20, & 22-24 (specifically, parent claims 1 & 17).

Conclusion

7. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306 (571-273-8300 as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

A handwritten signature in black ink, reading "Stephen Brinich". The signature is written in a cursive style with a large, stylized "S" and "B".

Stephen M Brinich
Examiner
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smb
July 7, 2005